

REMARKS

Claim Rejections - 35 USC 112

Claims 1-15 are rejected under 35 USC 112, first paragraph, because Claims 1 and 11 have been determined to be "single means" claims by the Patent Office. Applicant respectfully disagrees with this determination and traverses the rejection for the reasons given below.

Regarding Claim 11, this claim has been cancelled from the application, so the rejection is considered moot as it applies to Claim 11.

Regarding Claim 1, it is respectfully argued that this claim is in a format explicitly encouraged by 37 CFR 1.75(e), and that it is readily distinguishable from the claim at issue in *In re Hyatt* cited by the Patent Office.

37 CFR 1.75(e) reads as follows:

"Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

- (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,
- (2) A phrase such as "wherein the improvement comprises," and
- (3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion."

Claim 1 of the present application includes a preamble generally describing all the elements of the claimed combination that are conventional or known, namely, a non-scanning illumination device, an illumination beam path, a main objective, and a plurality of optical components in the illumination beam path. The preamble is followed by a transition phrase, namely "the improvement comprising". The claim then sets forth the elements and relationships of the claimed combination which are considered by Applicant to be new, specifically "a mechanism for moving at least one of said plurality of optical components so that a reduction of light intensity incident upon the subject over the field of view occurs because of the movement of said at least one optical component." The claim defines an invention that is an improvement in a microscope, and it recites some known elements and a new element, and relates the new element to the known elements. Although the comment in *In re Hyatt* that "a mere recital of a multitude of elements or steps in a claim is not determinative of the invention it defines" may be true, in the present case of Claim 1 we have a classic case of an improvement invention. There are many, many inventions characterized by the addition of a single new element to a previously known combination to produce a novel and patentable combination.

The claim at issue in *In re Hyatt* was as follows:

35. A Fourier transform processor for generating Fourier transformed incremental output signals in response to incremental input signals, said Fourier transform processor comprising incremental means for incrementally generating the Fourier transformed incremental output signals in response to the incremental input signals.

Here, the claimed invention is a "Fourier transform processor" that comprises only one element, namely "incremental means". The incremental means is defined in means plus function format and is not related to any other structural element. By contrast, in the improvement defined by Claim 1, there is a combination of interrelated structural elements.

It is important to note that the Court in *In re Hyatt*, in making its comment that "a mere recital of a multitude of elements or steps in a claim is not determinative of the invention it defines", was responding to the Appellant's argument that every noun in the claim constituted a separate element. The Court went on to remark "Appellant's denomination of every noun in the claim as a separate element ignores the fact that these words function as mere description of the single claimed means." That is not the case in present Claim 1, which clearly sets forth separate elements in the preamble and a further element in the novel portion. Thus, the comment from *In re Hyatt* relied upon in the Office Action, when looked at in proper context, does not support the characterization of Claim 1 as a "single means" claim.

For the reasons given above, it is respectfully requested that the rejection of Claims 1-15 under 35 USC 112, first paragraph, be withdrawn.

The rejection of Claims 2-5 and 9-10 under 35 USC 112, second paragraph, is respectfully overcome by changing "darkening" to --reduction of light intensity-- in these claims for purposes of proper antecedent basis. Removal of the rejection is respectfully requested.

Claim Rejections - 35 USC 103

The rejection of Claims 11 and 13 under 35 USC 103 is respectfully considered to be moot in view of the cancellation of these claims from the application. Claims 12, 14, and 15, previously dependent on Claim 11, have been re-presented in independent form. Withdrawal of the rejection is respectfully sought.

Conclusion

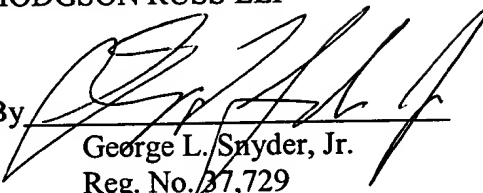
The present application is thought to be in a condition for allowance. Therefore, it is respectfully asked that a timely Notice of Allowance be issued in this application.

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Amendment and Response to Office Action
Reply to Office Action of March 18, 2003

Respectfully submitted,

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